REMARKS

I.   Introduction

The Final Action:

> Restricts out claims 23-25;
>
> Objects to the drawings under 37 C.F.R. § 1.83(a);
>
> Rejects claims 2, 3, 5, 6, and 22 under 35 U.S.C. § 102(e); and
>
> Rejects claims 4, 7-20 under 35 U.S.C. § 103(a).

This Response:

> Demonstrates that the restriction requirement is improper;
>
> Responds to the Examiner's objections to the drawings; and
>
> Traverses the rejections of record.

Claims 2-20 and 22-25 remain pending in the present application. In light of the arguments below, the Applicant respectfully asks the Examiner to withdraw the restriction requirement, the objection to the drawings, and all rejections to the pending claims.

II.   The Restriction Requirement

The Final Action contends that claims 23-25 are directed to an invention that is independent or distinct from the invention as originally claimed, and on that basis, withdraws from consideration claims 23-25. The Applicant respectfully points out, however, that the Final Action's stated points of distinction are indeed represented in both the claims currently pending claims and the claims as originally filed.

The Final Action points specifically to the "repair logic" and a "network card" of claim 23 as being absent from the claims as originally filed. The Applicant respectfully reminds the Examiner that, as originally filed, claim 7 recites "networked device manager at least partially defined by software components, said networked device manager responsive to a second message," which, while different in specific features and in scope, is clearly similar to the "network card" of claim 23. Further, claim 9, as originally filed, recites "wherein said second message instructs said networked device manager to cause said networked device to use redundant hardware," which is clearly foreshadows the "repair logic" of claim 23.

Moreover, the features the Final Action identifies from restricted claim 23 are clearly analogous to features in the non-restricted claims. Claim 22 recites "data collection logic" and "message generation logic," which are quite similar in functions to the "network card" and "appliance performance logic" of claim 23. When the above recited language of claims 7 and claim 9 (which now depend from claim 22) are added to the language of claim 22, it becomes impossible to support an argument that the claim set 2-20 and 22, should be restricted from the claim set 23-25.

Given that the features of claim 23 are clearly foreshadowed by the originally filed claims, and that a restriction requirement could not be support based upon the claims as they now stand, the Applicant respectfully asks the Examiner to withdraw the restriction.

III.   The Drawings

The Final Action objects to the drawings under 37 C.F.R. § 1.83(a) for ostensibly failing to show "said second message instructs said networked device manager to cause said networked device to use redundant hardware" and "said second message instructs said networked device manager to cause a reconfiguration of said networked device." However, the Applicant respectfully points out that Figure 3 clearly depicts an embodiment of both these features. In Figure 3, module 307 is shown switching between redundant elements 305 and 306 (which could also be a reconfiguration), and depicts module 307 being reconfigured with updated software module 304. Therefore, all of the features of the pending claims are depicted in the Figures, and the Applicant respectfully asks the Examiner to withdraw the objections.

IV.   The Rejections Under § 102(e)

Claims 2, 3, 5, 6, and 22 stand rejected as anticipated by Conrad, U.S. Patent No. 6,892,236 (hereinafter *Conrad*). However, M.P.E.P. § 2131 requires that, to be anticipatory, a reference must teach each and every limitation of the rejected claims. The Applicant respectfully asserts that *Conrad* does not satisfy this requirement for claims 2, 3, 5, 6, and 22.

Claim 22 recites "a networked device, connected to a digital network, performing a dedicated stand-alone function," and also recites "data collection logic configured to collect

information pertaining to said networked device's ability to perform said standalone function." Although the Final Action cites *Conrad* column 5 line 49 – column 6 line 23 as containing descriptions that meet most features, the Applicant respectfully asserts that no aspect of *Conrad* can be said to meet all of these limitations. The cited portion of *Conrad* describes a hierarchy of component-performance reporting taken by network reporting clients. While the ambiguity of the Final Action makes it impossible to determine whether the Examiner intends to match *Conrad's* "components" or *Conrad's* "reporting clients" to the "networked device" of claim 22, the Applicant respectfully assert that neither would suffice. If the Examiner intends the "components" to be "networked device[s]," then *Conrad* can not meet the limitation requiring a "networked device" to perform a dedicated, stand-alone function. If, on the other hand, the Examiner intends *Conrad's* "reporting clients" be "networked device[s]," then *Conrad* can not meet "data collection logic configured to collect information pertaining to said networked device's ability to perform said standalone function," as *Conrad* reports performance of "components" not "reporting clients." Therefore, *Conrad* fails to teach each and every limitation of claim 22, and the Applicant respectfully ask the Examiner to withdraw the rejection.

Claims 2, 3, 5, and 6 all depend from claim 22 and thus inherit that claim's limitations. While each of claims 2, 3, 5, and 6 recite limitations that make it patentable in its own right, each is at least patentable for depending from a patentable base claim. Therefore, the Applicant respectfully asks the Examiner to withdraw the rejection of claims 2, 3, 5, and 6 as well.

V.   Rejections Under 35 U.S.C. § 103(a)

Claims 4 and 7-20 stand rejected as obvious in light of various combinations of references.

A.   The Combination of *Conrad* and *Reichman*

Claims 4, 7, and 10 are rejected as obvious in view of a combination of *Conrad* and Reichman, U.S. Patent No. 6,738,813 (hereinafter *Reichman*). However, M.P.E.P. § 2143 requires that, in order to establish a prima facie case of obviousness, a cited combination must, among other things, teach or suggest each and every limitation of a rejected claim.

Without conceding that the Final Action has established the other criteria for establishing a prima facie case of obviousness, the Applicant respectfully submits that the proposed combination of *Conrad* and *Reichman* does not teach or suggest all the limitations of the claims rejected.

Each of claims 4, 7, and 10 depend from claim 22, and, thus, inherit all of that claims limitations. As Demonstrated above, *Conrad* does not teach or suggest "a networked device, connected to a digital network, performing a dedicated stand-alone function" and "data collection logic configured to collect information pertaining to said networked device's ability to perform said standalone function." Although not relied on to do so in the Final Action, the Applicant demonstrated, in the response to the Previous Office Action dated April 26, 2005, that *Reichman* did not teach or suggest these limitations either. Therefore, the combination of *Conrad* and *Reichman* does not teach or suggest all of the limitations of claims 4, 7, and 10, and the Final Action fails to establish a prima facie case for rejecting these claims. The Applicant respectfully asks the Examiner to withdraw the rejection of claims 4, 7, and 10.

B.   The Combination of *Conrad* and *Moberg*

Claims 12, 14, 15, and 20 stand rejected as obvious in view of *Conrad* and Moberg et al., U.S. Patent No. 6,738,826 (hereinafter *Moberg*). However, in order to establish a prima facie case of obviousness, M.P.E.P. § 2143 requires three criteria. First, the rejection must find a reasonable motivation for combining the proposed references in either the references themselves or in the information available to one of ordinary skill in the art. Second, the proposed combination must have had a reasonable likelihood of success. Third, the proposed combination must teach or suggest each and every limitation. Without conceding the second criteria, the Applicant respectfully asserts that the combination proposed by the Final Action does not satisfy either the first or third criteria.

The Final Action does not actually give a motivation for combining features of *Conrad* and *Moberg* to meet the limitations of claim 12, but, rather, merely refers to the motivation provided for claim 11. The Applicant respectfully asserts that this is inadequate, as the features of claim 11 are different from those of claim 12, and that this omission alone

is enough to demonstrate that the Final Action fails to establish a prima facie case. However, the Applicant respectfully asserts that no motivation could be found to make the proposed combination used to reject claim 12. *Conrad* describes a hierarch of component-performance reporting devices. No reason or need is given in *Conrad* for analyzing messages to determine an appropriate modification to any device monitored by *Conrad*, nor is any structure or programming described that would be capable of performing this function. Yet the Final Action appears to contend that it would be obvious to modify *Conrad* to perform this function, simply because *Moberg*, ostensibly, describes the ability to reprogram network routers. This logic flawed in two respects. First, *Conrad* and *Moberg* describe completely different systems, and one would need to substantially modify *Conrad* in order to perform any function from *Moberg*. The Final Action can not establish a prima facie case based on a proposed addition to *Conrad* requiring substantial unspecified alterations, particularly when the Final Action provides no statement to why one would want to add that functionality. Second, the feature the Final Action appears to want to add to *Conrad* isn't actually performed by *Moberg*. Claim 12 recites "automatically analyzing said message to determine an appropriate modification of said networked device." According to the Final Action, *Conrad* provides messages and analyzes them. *Moberg*, updates routers with replacement software. Neither *Moberg* nor *Conrad* analyze messages to determine a appropriate modification. Without conceding that such a combination could meet the limitations of claim 12, in order to add the updating feature of *Moberg* to *Conrad*, as the Final Action appears to suggest, one must first find someway to determine what must be uploaded. Neither *Conrad* nor *Moberg* suggest how to do so.

Therefore, no motivation exists for combining *Conrad* with *Moberg,* and even if one could be found, the combination would not teach or suggest all of the limitation of the rejected claim. Thus, Final Action fails to establish a prima facie case for rejecting claim 12, and the Applicant respectfully asks the Examiner to withdraw the rejection.

Claims 14, 15, and 20 depend from claim 12, and this inherit all of that claim's limitation. Although each recites limitations that make it patentable in it s own right, each is at least patentable for depending from a patentable base claim. Therefore, the Applicant respectfully asks the Examiner to withdraw the rejection of clams 14, 15, and 20 as well.

C.   The Combination of *Conrad, Reichman,* and *Oskay*

Claims 8 and 9 stand rejected as obvious in view of *Conrad, Reichman,* and Oskay et al., U.S. Patent No. 5,642,337 (hereinafter *Oskay*). However, both claims 8 and 9 depend from claim 22, and, thus, inherit all of that claims limitations. As Demonstrated above, *Conrad* does not teach or suggest "a networked device, connected to a digital network, performing a dedicated stand-alone function" and "data collection logic configured to collect information pertaining to said networked device's ability to perform said standalone function." Although not relied on to do so in the Final Action, the Applicant demonstrated that neither *Reichman* nor *Oskay* teaches or suggests these limitations in the response to the Previous Office Action dated April 26, 2005. Therefore, the combination of *Conrad, Reichman,* and *Oskay* does not teach or suggest all of the limitations of claims 8 or 9, and the Final Action fails to establish a prima facie case for rejecting these claims. The Applicant respectfully asks the Examiner to withdraw the rejection of claims 8 and 9.

D.   The Combination of *Conrad, Reichman,* and *Moberg*

Claims 11 and 16-19 are rejected as obvious in view of *Conrad, Reichman,* and *Moberg.* However, claim 11 depends from claim 22, and, thus, inherit all of that claims limitations. As Demonstrated above, *Conrad* does not teach or suggest "a networked device, connected to a digital network, performing a dedicated stand-alone function" and "data collection logic configured to collect information pertaining to said networked device's ability to perform said standalone function." Although not relied on to do so in the Final Action, the Applicant demonstrated, in the response to the Previous Office Action dated April 26, 2005, that *Reichman* did not teach these limitations either. Nor can *Moberg* be used to cure this defect, as *Moberg* describes updating routers, not devices performing a stand-alone function. Therefore, the combination of *Conrad, Reichman,* and *Moberg* do not teach or suggest all of the limitations of claim 11, and the Final Action fails to establish a prima facie case. The Applicant respectfully asks the Examiner to withdraw the rejection of claim 11.

Claims 16-19 depend from claim 12, and, thus, inherit all of that claims limitations. As Demonstrated above, the combination of *Conrad* and *Moberg* lacks motivation with respect to the features of claim 12, and also fails teach or suggest the all the features the Final Action appears to want to combine. Although not relied on to do so in the Final Action, the

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Applicant respectfully asserts that *Reichman* neither provides the missing motivation nor provides the missing limitations. Therefore, the combination of *Conrad, Reichman,* and *Moberg* fails to establish a prima facie case. The Applicant respectfully asks the Examiner to withdraw the rejection of claims 16-19.

VI.   Conclusion

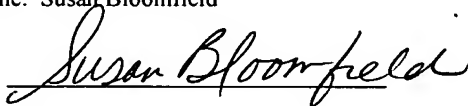In view of the above, the Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10005002-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482712540US, in an envelope addressed to: MS AF, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: October 11, 2005

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Respectfully submitted,

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